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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,513	01/03/2001	Michael Mesh	S0489/7010 GSE	3166
23338	7590	05/17/2005	EXAMINER	
DENNISON, SCHULTZ, DOUGHERTY & MACDONALD			WONG, BLANCHE	
1727 KING STREET			ART UNIT	
SUITE 105			PAPER NUMBER	
ALEXANDRIA, VA 22314			2667	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,513

Applicant(s)

MESH ET AL.

Examiner

Blanche Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because Fig. 1 does not have descriptive legend nor label.

Claim Objections

2. Claims 1-4,12,14,16 are objected to because of the following informalities:
 - With regard to cl. 1, ln. 6,14,17, Examiner suggests to replace – services – with “services data”.
 - With regard to cl. 1, ln. 9, Examiner suggests to replace – services – with “packets”.
 - With regard to cl. 2, ln. 4, Examiner suggests to replace – services – with “services data”.
 - With regard to cl. 3, ln. 4, Examiner suggests to replace – services – with “services data”.
 - With regard to cl. 4, ln. 4, Examiner suggests to replace – service – with “services data”.
 - With regard to cl. 4, ln. 5, Examiner suggests to replace – services – with “services data”.
 - With regard to cl. 12, ln. 4 and 5, Examiner suggests to replace – transceivers – with “optical transceiver”.
 - With regard to cl. 14, ln. 10, Examiner suggests to replace – service – with “services data”.

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- With regard to cl. 16, ln. 6, Examiner suggests to replace – (wavelengths) – with “having different wavelengths”, as in cl. 5, ln. 6-7.
- With regard to cl. 18, ln. 4,6,7,17,19, Examiner suggests to replace – services – with “services data”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1-19** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 lacks enablement. Cl. 1 claims a system that comprises of a service collection unit and an aggregator. The combination is not taught in this application.

Specification, p. 10-13, discloses a service collection unit that can receive (collect) via service interface 84, process into packet through packetization 86, and convert into optical signal via framer 92. The embodiment of a service collection unit is illustrated in Fig. 4. Specification, p. 13-14, discloses an aggregator that has two functions: sorting and aggregating. The embodiment of an aggregator is illustrated in Fig. 5. The service collection unit Fig. 4 and aggregator Fig. 5 are mutually exclusive

embodiment. However, claim 1 recites "a system ... comprising: a service collection unit ... and an aggregator." Claim 1 combines a service collection unit and an aggregator. This combination or its working is not disclosed in the Specification, and thus lacks enablement.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claim 1 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/753399. Although the conflicting claims are not identical, they are not patentably distinct from each other because 09/753399 discloses a method for data transmission over an optical network that performs the functions of a service collection unit and an aggregator, namely "collecting, in at least one service collection unit, ... processing ... into packets, converting packets into optical signals ... sorting ... in at least one aggregator module, ... ", and the current application discloses a system for data transmission over an optical network with a service collection unit and an

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aggregator. It would have been obvious that a system cannot perform without a method.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

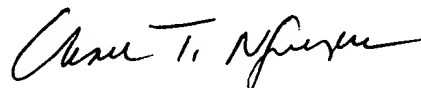
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blanche Wong whose telephone number is 571-272-3177. The examiner can normally be reached on Monday through Friday, 830am to 530pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BW

BW
April 29, 2005



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SUPERVISORY PATENT EXAMINER
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